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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,296	10/31/2001	Thomas D. Benson	10004991 -1	8164

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EXAMINER	
FISCHETTI, JOSEPH A	
ART UNIT	**PAPER NUMBER**
3627	

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,296	BENSON	
	Examiner	Art Unit	
	Joseph A. Fischetti	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *1-7 and 15-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

Newly submitted claims 21-29 directed to inventions that are independent or distinct from the invention originally claimed for the following reasons: the elected group II was drawn to a method, and the subject matter of claims 21-29 is drawn to a device/code (the word "system" as used in Group II of the restriction was a misprint and should have been correctly printed as --method--.).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim, 1 it is unclear what is meant by "electronically", if applicant wishes to state that the data is generated by computer, then he should say it. Second, who determines the required quantity, the supplier or user? Also, this information is communicated from where to where?

In claim 14, it is unclear what is being compared. "Compare" is normally read to mean between two entities, but this claim recites four such entities. That is, is the actual run rate compared to both an anticipated run rate and an actual production yield? Also these rates and yields need to be referenced to something to have meaning in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

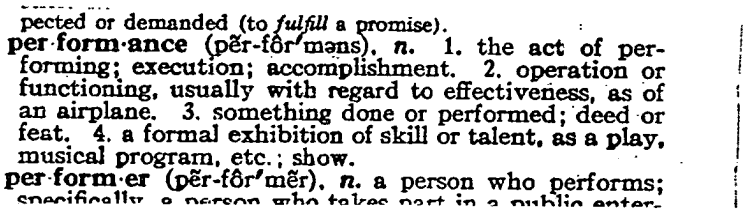
Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no recited utilization of any technical art in the claim, as such, it can be accomplished purely by human intervention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-11,13 are rejected under 35 U.S.C. 102(b) as being anticipated by Graves et al. Graves et al. disclose determining, electronically, a required quantity of a material (col. 6 lines 50 et seq., the processing unit 106 having forecasting algorithms); communicating said quantity and a time frame to a supplier of said material (col. 6 purchase orders are transmitted to supplier based on these estimates; receiving a confirmation message from said supplier (col. 7 line 32 re confirmation from supplier); and using feedback to maintain a desired quantity of said material on hand, wherein said feedback is utilized in re-determining said required quantity of a material (see col. 17 lines 28-47 wherein a feedback process is used to re-calculate the needed amount of re-supply. Since the feedback is based upon actual levels or functioning, the feedback is based upon performance Webster's New World Dictionary defines performance as "operation or functioning,...").


pected or demanded (to *fulfill* a promise).
per·form·ance (pĕr-fôr′məns), *n.* 1. the act of performing; execution; accomplishment. 2. operation or functioning, usually with regard to effectiveness, as of an airplane. 3. something done or performed; deed or feat. 4. a formal exhibition of skill or talent, as a play, musical program, etc.; show.
per·form·er (pĕr-fôr′mĕr), *n.* a person who performs; specifically, a person who takes part in a public enter-

Re claim 9: col. 17 lines 28-47 wherein a feedback process is used to re-calculate the needed amount of re-supply is done by way of a later in time communication of said quantity and time frame to said supplier as a function of said feedback.

Re claim 10: the step of determining includes processing a product forecast col. 6 line 50-52 and a desired level (see col. 5 line 7 re: level).

Re claims 11, and 13 see col. 18, lines 3-7 which discloses communicating via an ISDN which is a from of the internet.

Re claim 14 as best understood, see col. 17 lines 28-47 wherein a feedback process is used to re-calculate the needed amount of re-supply which involves a comparison between actual and theoretical.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves et al.

Graves et al discloses communicating to notify supplier of a order and a reminder is deemed to be a mere repetition of that initial step.

Arguments Reply:

Applicant's arguments filed 5/13/04 have been fully considered but they are not persuasive. First applicant challenges the 1010 rejection as failing to provide precedent for the technological arts requirement. Accordingly , In June 2001, the U.S. Patent Office Board of Patent Appeals and Interference rendered a nonprecedential decision which effectively maintained a two-prong test, one of the prongs being a technological arts requirement and the other being the ultimate issue standard. The case is *Ex parte Bowman*, and was published at 61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001). The claims recite method steps for an intangible asset of interest reciting, *inter alia*, steps of

"establishing first and second variables...," "establishing a series of performance criteria statements...," "scoring each...statements...," and "summary scores..." . The Board, restating dicta in Benson, defined the phrase "technological arts" as "created to offer another view of the term 'useful arts'". The opinion goes on further to justify the doctrine's use by stating:

> [t]he Constitution of the United States authorizes and empowers the government to issue patents only for inventions which promote the progress [of science and] the useful arts.

With that said, the opinion thus determines that the *Bowman* claims do "not fall within the definition of technological arts" because "the claimed invention...is nothing more than an abstract idea [since] it is not tied to any technological art or environment". Thus, such claims cannot promote the progress of science and the useful arts as mandated under art. I, § 8, cl. 8 of the United States Constitution.

Second, Applicant challenges the 112 second paragraph rejection stating that the language is intentionally broad. However, while Applicant does have the right to claim the invention as he desires with respect to scope, such claims nevertheless need to be drawn so narrowly as to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The examiner is the test and in this case he has determined that there is insufficient structure recited sufficient to distinctly claim an

invention. This is particularly proven true in Applicant's failed attempt to distinguish claim 14 from the prior art by arguments rather than by claim limitations which are not recited.

Third, Applicant argues that the 103 rejection of claim 12 is in error because there is no stated motivation for employing the repetition of parts/steps application to the 103 rejection. As is clear from the rejection, there is no combining of any additional reference here. All that was done was to read the reminder step as a mere repeat of the initial notification step. The doctrine of repletion of parts does not need to be supported by motivation- it exists as a corollary in 103. *See e.g, In re COEY AND PETERSEN*, 90 USPQ 216 (CCPA 1951) (the addition of a third coating step and drying step was mere obvious repetition).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory

action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.